

Docket No.: **SS-133**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|------------------------------------|---|-----------------------------|
| App. No.: 10/798,765               | ) | Examiner: Walczak, David J. |
|                                    | ) |                             |
| Title: ILLUMINATED HIGHLIGHTER AND | ) |                             |
| ADVERTISING VEHICLE                | ) | Art Unit: 3751              |
|                                    | ) |                             |
| Inventor: Oas, Dan                 | ) |                             |
|                                    | ) |                             |
| Filed: 03/10/2004                  | ) |                             |
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**RESPONSE TO OFFICE ACTION MAILED 05/23/2006**

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

**I. Summary of Office Action**

On May 23, 2006, the Examiner mailed a non-final office action in relation to the application identified above. The Examiner objected to the abstract for using phrases that can be implied under MPEP § 608.01(b).

The Examiner rejected Claims 1, 6, 8, 9, and 12 under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,045,111 issued to Hoenig ("Hoenig reference"). The Examiner also rejected Claims 2-5, 10, 11, and 13-16 under 35 U.S.C. 103(a) as being unpatentable over the Hoenig reference and taking official notice. The Examiner further rejected Claims 7 and 17 under 35 U.S.C. 103(a) as being unpatentable over the Hoenig reference in view of US Patent

No. 6,299,372 issued to Wang (“Wang reference”).

## **II. Applicant’s Response**

### **A. Abstract**

Applicant amended the abstract to remove the phrases objected to as shown in the marked-up copy of the abstract. Applicant respectfully submits that such amendments overcome the stated objection.

### **B. Amended Claims 1, 6, 8, 9, and 12 Are Not Anticipated by the Hoenig Reference**

Applicant respectfully submits that the Hoenig reference cannot anticipate amended independent Claims 1 and 8 because the Hoenig reference fails to disclose a light source configured to direct a majority of light upon the ink reservoir for illuminating the ink therein, an ink reservoir defined by the instrument body, a light conducting member in fluid communication with the ink reservoir, or a transparent/translucent ink reservoir.

Anticipation requires that each and every element of the claimed invention be disclosed in a single relevant prior art reference. *Akzo N.V. v. United States Int’l Trade Comm’n*, 1 USPQ 1241, 1245 (Fe. Cir. 1987). The prior art must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Id.* Although drawings and pictures can anticipate claims if they clearly show the structure which is claimed, *In re Mraz*, 455 F.2d 1069; MPEP 2125, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928); MPEP 2125.

As understood by Applicant, neither the light-transmitting connector member 25 disclosed in Hoenig nor any other part of the writing instrument in the Hoenig reference provides

a light source majority of light emitted from the light source be directed into the ink reservoir so as to illuminate the ink in the ink reservoir. As understood by Applicant, the Hoenig reference makes it clear that the light conducting member **25** and other parts of the invention are structured to direct the light from the light source into a region outside the ink reservoir 12 to concentrate it onto a writing surface around the pen tip, not into the ink cartridge 12 which is blocked at an end by the pen tip **16**. The directing of light in this manner is expressly a stated objective in the Hoenig reference, i.e., lighting up only the area around the pen tip in the dark without disturbing other people. (*See*, Hoenig, Col. 1 lns. 10-15; *see also* Col. 65-69).

To achieve such a purpose, Hoenig teaches that the annular grooves **29** are formed on the light conducting member **25** “direct the rays of the light source downwardly towards the writing surface” and that the light is further directed “through the circular grooves **17** in the light-transmitting tip member **9** to the surface of the paper.” (Hoenig, col. 3 lns. 45-52). FIGS. 3-4 also clearly show that, by the operation of the annular grooves **29** and the circular grooves **17**, the light ray emitted from the lamp **28** directs downward in parallel to the axis of the ink cartridge **12**, passing through the region outside the cartridge 12 and following the outer region of the light-transmitting tip member 9, rather than entering into the cartridge **12**. Hoenig further confirms that in stating that “the rays of light take the direction indicated by the arrows in such figure (FIG. 4).” Moreover, the detailed physical structure of the annular grooves **29** and the circular grooves **17** and the related optical mechanism that enable rays of light to be guided in such a way are expounded in the specification as well. (*See* Specification, Col. 5 lns. 72 - Col. 6 lns.23).

Therefore, Applicant submits that the Examiner’s assertion that the ink reservoir is illuminated by the light source is incompatible with the object of Hoenig. In fact, Applicant

submits that the Examiner fails to provide any support for the possibility that the light could even be directed upon the ink reservoir 12. In fact, even assuming *arguendo*, Applicant submits that directing light into the ink cartridge 12 would detract from the object of the invention, which is to direct such light upon the writing area, not the ink reservoir.

Amended independent Claim 8 is further distinguishable because the light conducting member 25 in the Hoenig reference is not in fluid communication with the ink reservoir 12 as claimed in amended Claim 8. The ink cartridge 12 is a conventional type (Hoenig, Col. 3 lns. 13-14) which is typically not filled up to reach the end 23 of the cartridge 12 where tip member 24 of the light conducting member 25 is connected. Further, the cartridge 12 has a “conventional crimp 22” formed therein, (Hoenig, Col. 3 lns. 21), which Applicant understands as serving at least two purposes: 1) to retain the spring 14 thereagainst, and 2) to block the ink from further moving upward to prevent undesirable leakage at the end 23 of the cartridge 12. Therefore, Applicant submits that the structure of a conventional ink cartridge 12 would not permit the ink therein to be in fluid communication with the light conducting member 25. More importantly, there is nothing in the Hoenig reference that indicates, explicitly or inherently, that the light conducting member 25 can be in contact with the ink contained in the ink reservoir 12 .

As understood by Applicant, the ink reservoir 12 disclosed in the Hoenig reference merely provides for a conventional replaceable ink cartridge, or a separate container replaceably fitted into a cavity (axial bore 11) instead of an ink reservoir defined by the instrument body, as claimed in the present invention. As stated in Hoenig, “an axial bore 11 through which the ball-point writing cartridge 12 may be extended or withdrawn . . .” (Hoenig, col. 2 lns. 65-66), and “[t]he ball-point cartridge 12 is of conventional construction” (Hoenig, col. 3 lns. 13-14). Even further, “if the ball-point cartridge 12 becomes dry it is easy to replace the cartridge 12 by merely

removing the same and replacing it with a new cartridge **12**" (Hoenig, col. 6 lns. 40-43). FIGS. 1-3 of the Hoenig reference also illustrate this distinction. Thus, at best, Hoenig appears to disclose an ink cartridge that is a separate component apart from the pen body.

Such a multi-piece construction that provides a replaceable ink cartridge is distinguishable from the ink reservoir that is defined by the instrument body as claimed in amended Claims 1 and 8. Advantageously, because the ink reservoir is defined by the instrument body, the illumination and visibility of ink inside the ink reservoir is enhanced when light is directed thereupon.

Finally, Applicant respectfully submits that Hoenig does not disclose the ink reservoir being fabricated of light transmitting material. The Examiner admits this in rejecting Claims 2, 3, 10, and 11 under 35 U.S.C. 103(a), that "the Hoenig reference does not disclose that the reservoir is formed from material that is at least partially transparent/transucent."

Since the Hoenig reference fails to disclose any of these limitations of amended independent Claims 1 and 8 as discussed above, Applicant submits that claims 1 and 8, and dependent Claims 6, 9, and 12, as well as new Claims 24-35, are distinguishable from Hoenig.

**C. Dependent Claims 2, 3, 10 and 11 Are Not Obvious over the Hoenig Reference.**

In the respect that amended independent Claims 1 and 8 are believed to be allowable, dependent Claims 2, 3, 10, and 11 are also believed to be allowable.

**D. Dependent Claims 4, 5, 13-16 Are Not Obvious over the Hoenig Reference.**

In the respect that amended independent Claims 1 and 8 are believed to be allowable, dependent Claims 4, 5, and 13-16 are also believed to be allowable.

Even assuming *arguendo*, Applicant submits that the Examiner failed to meet the burden of establishing the *prima facie* case of obviousness by finding some teaching, suggestion, or motivation, in the Hoenig references either explicitly or implicitly, in the knowledge generally available to one of ordinary skill in the art, or in the nature of problem to be solved, to modify the ball-point pen light in the Hoenig reference to employ LED or ultraviolet light source, fluorescent ink, or a highlighter type of tip, the features of Claims 4, 5, 13-16.

It is well settled that to combine or modify prior art references to produce the claimed invention in establishing a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves, the knowledge generally available to one of ordinary skill in the art, or the nature of problem to be solved. *See In re Dembiczak*, 175 F.3d 999, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); MPEP 2143. In analyzing obviousness of patent, an express or implicit showing of some motivation, suggestion, or teaching to combine prior art elements must be based on particular findings related thereto, and broad conclusory statements standing alone are not evidence. *Id.* at 999. Also, To modify references, there must be some suggestion to do so, even for simple changes or combinations. *See In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) (“Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down”). To modify a prior art reference to render a patent obvious requires that “the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The Examiner stated that modifying the invention in the Hoenig reference would have been obvious to one of ordinary skill in the art at the time the invention was made because the

Hoenig device can be equipped with any suitable ink, tip, or light source without effecting the overall operation of the device. Yet, no explicit or implicit indication can be found in the Hoenig reference that any kind of suitable ink, tip, or light source can be used as well instead of the disclosed typical ball-point pen ink, ball-point pen tip, or the typical light bulb. To the contrary, the Hoenig reference makes it clear that its invention relates specifically to “a ball-point pen construction” (Hoenig, Col. 1 Ins. 7-8), and repeatedly states that its object is “to provide a ball-point pen” including its novel features. (*See* Hoenig, Col. 1 Ins. 50-51, 59-60). Further, it discloses that its device uses “a standard miniature bulb.” (Hoenig, Col. 2 Ins. 10-11). As understood by Applicant, there is nothing in the Hoenig reference that alludes the possibility that its ball-point pen ink, tip, or light bulb may be replaced with, or modified into, others. The Examiner failed to find, by pointing out any specific words or phrases in the Hoenig reference, any desirability of such modification.

As the Federal Circuit held, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *Id.*, at 972. Where the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why the combination of reference teachings is proper. *Ex Parte Skinner*, 2 USPQ 2d. 1788, 1790 (B.P.A.I. 1986).

The Examiner asserted a further reason for obviousness the alleged fact that Applicant “has not placed any criticality on these features and discloses that any suitable ink or tip may be employed by the instant invention” in the specification. Applicant respectfully submits that even if such assertions are taken to be true, the failure to place any “criticality” upon any particular features does not provide any basis for rejecting claims under 35 U.S.C. 103(a) and the Examiner

fails to cite to the MPEP or any relevant law for such support.

Finally, Applicant submits that modification to dependant Claim 14 to employ an ultraviolet light source as suggested by the Examiner would teach away from an objective of the Hoenig reference to light up a writing surface near the tip since ultraviolet light is invisible. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or modification to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, Applicant respectfully submits that suggestion or motivation cited by the Examiner is at best a result of impermissible hindsight construction and cannot be sufficient legal basis to create obviousness under 35 U.S.C. 103(a).

For the reasons stated above, Applicant respectfully submits that dependent Claims 4, 5, and 13-16 should not be deemed obvious over the Hoenig reference.

**E. Dependent Claims 7 and 17 Are Not Obvious over the Hoenig Reference in view of the Wang Reference.**

In the respect that amended independent Claims 1 and 8 are believed to be allowable, dependent Claims 2, 3, 10, and 11 are also believed to be allowable.

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### III. Conclusion

For all the reasons set forth herein, Applicant respectfully submits that the application is in condition for allowance and requests that such action be taken by the Examiner.

Respectfully Submitted,

Date: 9/7/06

By:

A handwritten signature in black ink, appearing to read 'S. Bang', with a long horizontal flourish extending to the right.

Stephen T. Bang

Registration No. 48,926

THE SONI LAW FIRM

55 S. Lake Avenue, Suite 720

Pasadena, CA 91101

Phone: (626) 683-7600

Fax: (626) 683-1199

Email: [stephen@sonilaw.com](mailto:stephen@sonilaw.com)